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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,429	11/29/2002	Jane E Aubin	3477.95	6914

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EXAMINER	
VIVLEMORE, TRACY ANN	

ART UNIT	PAPER NUMBER
1635	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/089,429	AUBIN ET AL.	
	Examiner	Art Unit	
	Tracy Vivlemore	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1,9, drawn to a method to increase proliferation of osteoblasts in a mammal with an agent wherein the agent is an ERRα agonist.

Group II, claim(s) 1,9, drawn to a method to increase proliferation of osteoblasts in a mammal with an agent wherein the agent is a substantially purified ERRα protein.

Group III, claim(s) 1,9, drawn to a method to increase proliferation of osteoblasts in a mammal with an agent wherein the agent is a nucleotide sequence encoding ERRα protein.

Group IV, claim(s) 1,9, drawn to a method to increase proliferation of osteoblasts in a mammal with an agent wherein the agent is an agent which enhances expression of a gene encoding an ERRα protein.

Group V, claim(s) 2, drawn to a method to increase differentiation of osteoblasts in a mammal with an agent wherein the agent is an ERRα agonist.

Group VI, claim(s) 2, drawn to a method to increase differentiation of osteoblasts in a mammal with an agent wherein the agent is a substantially purified ERRα protein.

Group VII, claim(s) 2, drawn to a method to increase differentiation of osteoblasts in a mammal with an agent wherein the agent is a nucleotide sequence encoding ERRα protein.

Group VIII, claim(s) 2, drawn to a method to increase differentiation of osteoblasts in a mammal with an agent wherein the agent is an agent which enhances expression of a gene encoding an ERRα protein.

Group IX, claim(s) 3, drawn to a method of reducing proliferation of osteoblasts in a mammal with an agent wherein the agent is an ERRα antagonist.

Group X, claim(s) 3, drawn to a method of reducing proliferation of osteoblasts in a mammal with an agent wherein the agent is a purified antibody which binds specifically to an ERRα protein.

Group XI, claim(s) 3, drawn to a method of reducing proliferation of osteoblasts in a mammal with an agent wherein the agent is an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein.

Group XII, claim(s) 3, drawn to a method of reducing proliferation of osteoblasts in a mammal with an agent wherein the agent is an agent which reduces expression of a gene encoding an ERRα protein.

Group XIII, claim(s) 4, drawn to a method of reducing differentiation of osteoblasts in a mammal with an agent wherein the agent is an ERRα antagonist.

Group XIV, claim(s) 4, drawn to a method of reducing differentiation of osteoblasts in a mammal with an agent wherein the agent is a purified antibody which binds specifically to an ERRα protein.

Group XV, claim(s) 4, drawn to a method of reducing differentiation of osteoblasts in a mammal with an agent wherein the agent is an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein.

Group XVI, claim(s) 4, drawn to a method of reducing differentiation of osteoblasts in a mammal with an agent wherein the agent is an agent which reduces expression of a gene encoding an ERRα protein.

Group XVII, claim(s) 5, 6, drawn to a method for treating a disorder associated with bone loss in a mammal with an agent wherein the agent is an ERRα agonist.

Group XVIII, claim(s) 5, 6, drawn to a method for treating a disorder associated with bone loss in a mammal with an agent wherein the agent is a substantially purified ERRα protein.

Group XIX, claim(s) 5, 6, drawn to a method for treating a disorder associated with bone loss in a mammal with an agent wherein the agent is a nucleotide sequence encoding ERRα protein.

Group XX, claim(s) 5, 6, drawn to a method for treating a disorder associated with bone loss in a mammal with an agent wherein the agent is an agent which enhances expression of a gene encoding an ERRα protein.

Group XXI, claim(s) 7, 8, drawn to a method for treating a disorder associated with unwanted bone growth in a mammal with an agent wherein the agent is an ERRα antagonist.

Group XXII, claim(s) 7, 8, drawn to a method for treating a disorder associated with unwanted bone growth in a mammal with an agent wherein the agent is a purified antibody which binds specifically to an ERRα protein.

Group XXIII, claim(s) 7, 8, drawn to a method for treating a disorder associated with unwanted bone growth in a mammal with an agent wherein the agent is an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein.

Group XXIV, claim(s) 7, 8, drawn to a method for treating a disorder associated with unwanted bone growth in a mammal with an agent wherein the agent is an agent which reduces expression of a gene encoding an ERRα protein.

Group XXV, claim(s) 10, 11, drawn to a method of screening a compound for its ability to modulate ERRα activity.

Group XXVI, claim(s) 12, drawn to a method of screening a compound for potential efficacy in promoting bone formation.

Group XXVII, claim(s) 13, drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

Group XXVIII, claim(s) 14, drawn to a pharmaceutical composition of an agent wherein the agent is an ERRα agonist.

Group XXIX, claim(s) 14, drawn to a pharmaceutical composition of an agent wherein the agent is a substantially purified ERRα protein.

Group XXX, claim(s) 14, drawn to a pharmaceutical composition of an agent wherein the agent is a nucleotide sequence encoding ERRα protein and a pharmaceutically acceptable carrier.

Group XXXI, claim(s) 14, drawn to a pharmaceutical composition of an agent wherein the agent is an agent which enhances expression of a gene encoding an ERRα protein.

Group XXXII, claim(s) 15, drawn to a pharmaceutical composition of an agent wherein the agent is an ERRα antagonist.

Group XXXIII, claim(s) 15, drawn to a pharmaceutical composition of an agent wherein the agent is a purified antibody which binds specifically to an ERRα protein.

Group XXXIV, claim(s) 15, drawn to a pharmaceutical composition of an agent wherein the agent is an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein.

Group XXXV, claim(s) 15, drawn to a pharmaceutical composition of an agent wherein the agent is an agent which reduces expression of the gene encoding ERRα protein and a pharmaceutically acceptable carrier.

1. The inventions listed as Groups I-XXXV do not relate to a single general inventive concept under PCT Rule 13.1 because, according to PCT Rule 13.2 and to the guidelines in Section (f)(i)(B)(1) of Annex B of the PCT Administrative Instructions, all alternatives of a Markush Group must have a common structure. Claims 1-5, 7, 14,

15 contain Markush groups which do not have a common structure. Each of these claims contains a Markush Group containing, among other things, both nucleotide sequences and proteins, which do not share a common structure. Thus they do not share a special technical feature.

2. The inventions listed as groups I, II, III and IV lack a special technical feature for the following reasons: group I uses an ERRα agonist to increase proliferation of osteoblasts in a mammal, group II uses a substantially purified ERRα protein to increase proliferation of osteoblasts in a mammal, group III uses a nucleotide sequence encoding ERRα protein to increase proliferation of osteoblasts in a mammal and group IV uses an agent which enhances expression of a gene encoding an ERRα protein to increase proliferation of osteoblasts in a mammal.

3. The inventions listed as groups V, VI, VII and VIII lack a special technical feature for the following reasons: group V uses an ERRα agonist to increase differentiation of osteoblasts in a mammal, group VI uses a substantially purified ERRα protein to increase differentiation of osteoblasts in a mammal, group VII uses a nucleotide sequence encoding ERRα protein to increase differentiation of osteoblasts in a mammal and group VIII uses an agent which enhances expression of a gene encoding an ERRα protein to increase differentiation of osteoblasts in a mammal.

4. The inventions listed as groups IX, X, XI and XII lack a special technical feature for the following reasons: group IX uses an ERRα antagonist to reduce proliferation of osteoblasts in a mammal, group X uses a purified antibody which binds specifically to an ERRα protein to reduce proliferation of osteoblasts in a mammal, group XI uses an

antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein to reduce proliferation of osteoblasts in a mammal and group XII uses an agent which reduces expression of a gene encoding an ERRα protein to reduce proliferation of osteoblasts in a mammal.

5. The inventions listed as groups XIII, XIV, XV, XVI lack a special technical feature for the following reasons: group XIII uses an ERRα antagonist to reduce differentiation of osteoblasts in a mammal, group XIV uses a purified antibody which binds specifically to an ERRα protein to reduce differentiation of osteoblasts in a mammal, group XV uses an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein to reduce differentiation of osteoblasts in a mammal and group XVI uses an agent which reduces expression of a gene encoding an ERRα protein to reduce differentiation of osteoblasts in a mammal.

6. The inventions listed as groups XVII, XVIII, XIX and XX lack a special technical feature for the following reasons: group XVII uses an ERRα agonist to treat a disorder associated with bone loss in a mammal, group XVIII uses a substantially purified ERRα protein to treat a disorder associated with bone loss in a mammal, group XIX uses a nucleotide sequence encoding ERRα protein to treat a disorder associated with bone loss in a mammal and group XX uses an agent which enhances expression of a gene encoding an ERRα protein to treat a disorder associated with bone loss in a mammal.

7. The inventions listed as groups XXI, XXII, XXIII, XXIV lack a special technical feature for the following reasons: group XXI uses an ERRα antagonist to treat a disorder associated with unwanted bone growth in a mammal, group XXII uses a purified

antibody which binds specifically to an ERRα protein to treat a disorder associated with unwanted bone growth in a mammal, group XXIII uses an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein to treat a disorder associated with unwanted bone growth in a mammal and group XXIV uses an agent which reduces expression of a gene encoding an ERRα protein to treat a disorder associated with unwanted bone growth in a mammal.

8. The inventions listed as groups I-IV and groups V-VIII lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while groups V-VIII are drawn to a method of increasing differentiation of osteoblasts in a mammal.

9. The inventions listed as groups I-IV and groups IX-XII lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal.

10. The inventions listed as groups I-IV and groups XIII-XVI lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while groups XIII-XVI are drawn to a method of reducing differentiation of osteoblasts in a mammal.

11. The inventions listed as groups I-IV and groups XVII-XX lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing

proliferation of osteoblasts in a mammal while groups XVII-XX are drawn to a method of treating a disorder associated with bone loss.

12. The inventions listed as groups I-IV and groups XXI-XXIV lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while groups XXI-XXIV are drawn to a method of treating a disorder associated with unwanted bone growth.

13. The inventions listed as groups I-IV and group XXV lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity.

14. The inventions listed as groups I-IV and group XXVI lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

15. The inventions listed as groups I-IV and group XXVII lack a special technical feature for the following reasons: groups I-IV are drawn to a method for increasing proliferation of osteoblasts in a mammal while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

16. The inventions listed as groups XXVIII-XXXV lack a special technical feature for the following reasons: group XXVIII uses an ERRα agonist to form the composition, group XXIX uses a substantially purified ERRα protein to form the composition, group XXX uses a nucleotide sequence encoding ERRα protein and a pharmaceutically

acceptable carrier to form the composition, group XXXI uses an agent which enhances expression of a gene encoding an ERRα protein to form the composition, group XXXII uses an ERRα antagonist to form the composition, group XXXIII uses a purified antibody which binds specifically to an ERRα protein to form the composition, group XXXIV uses an antisense nucleotide sequence complementary to and capable of hybridizing to a nucleotide sequence encoding ERRα protein to form the composition and group XXXV uses an agent which reduces expression of a gene encoding an ERRα protein and a pharmaceutically acceptable carrier to form the composition.

17. The inventions listed as groups I-IV and groups XXVIII-XXXV lack a special technical feature for the following reasons: groups I-IV is drawn to a method for increasing proliferation of osteoblasts in a mammal while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

18. The inventions listed as groups V-VIII and groups IX-XII lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal.

19. The inventions listed as groups V-VIII and groups XXIII-XVI lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while groups XXIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal.

20. The inventions listed as groups V-VIII and groups XVII-XX lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for

increasing differentiation of osteoblasts in a mammal while groups XVII-XX are drawn to a method for treating a disorder associated with bone loss.

21. The inventions listed as groups V-VIII and groups XXI-XXIV lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while groups XXI-XXIV are drawn to a method for treating a disorder associated with unwanted bone growth.

22. The inventions listed as groups V-VIII and group XXV lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity.

23. The inventions listed as groups V-VIII and group XXVI lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

24. The inventions listed as groups V-VIII and group XXVII lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

25. The inventions listed as groups V-VIII and groups XXVIII-XXXV lack a special technical feature for the following reasons: groups V-VIII are drawn to a method for increasing differentiation of osteoblasts in a mammal while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

26. The inventions listed as groups IX-XII and groups XIII-XVI lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal while groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal.

27. The inventions listed as groups IX-XII and groups XVII-XX lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal while groups XVII-XX are drawn to a method for treating a disorder associated with bone loss.

28. The inventions listed as groups IX-XII and groups XXI-XXIV lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal while groups XXI-XXIV are drawn to a method for treating a disorder associated with unwanted bone growth.

29. The inventions listed as groups IX-XII and group XXV lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal while group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity.

30. The inventions listed as groups IX-XII and group XXVI lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

31. The inventions listed as groups IX-XII and group XXVII lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing

proliferation of osteoblasts in a mammal while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

32. The inventions listed as groups IX-XII and groups XXVIII-XXXV lack a special technical feature for the following reasons: groups IX-XII are drawn to a method of reducing proliferation of osteoblasts in a mammal while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

33. The inventions listed as groups XIII-XVI and groups XVII-XX lack a special technical feature for the following reasons: groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal while groups XVII-XX are drawn to a method for treating a disorder associated with bone loss.

34. The inventions listed as groups XIII-XVI and groups XXI-XIV lack a special technical feature for the following reasons: groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal while groups XXI-XIV are drawn to a method for treating a disorder associated with unwanted bone growth.

35. The inventions listed as groups XIII-XVI and group XXV lack a special technical feature for the following reasons: groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal while group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity.

36. The inventions listed as groups XIII-XVI and group XXVI lack a special technical feature for the following reasons: groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

37. The inventions listed as groups XIII-XVI and group XXVII lack a special technical feature for the following reasons: groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

38. The inventions listed as groups XIII-XVI and groups XXVIII-XXXV lack a special technical feature for the following reasons: groups XIII-XVI are drawn to a method for reducing differentiation of osteoblasts in a mammal while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

39. The inventions listed as groups XVII-XX and groups XXI-XIV lack a special technical feature for the following reasons: groups XVII-XX are drawn to a method for treating a disorder associated with bone loss while groups XXI-XIV are drawn to a method for treating a disorder associated with unwanted bone growth.

40. The inventions listed as groups XVII-XX and group XXV lack a special technical feature for the following reasons: groups XVII-XX are drawn to a method for treating a disorder associated with bone loss while group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity.

41. The inventions listed as groups XVII-XX and group XXVI lack a special technical feature for the following reasons: groups XVII-XX are drawn to a method for treating a disorder associated with bone loss while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

42. The inventions listed as groups XVII-XX and group XXVII lack a special technical feature for the following reasons: groups XVII-XX are drawn to a method for treating a

disorder associated with bone loss while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

43. The inventions listed as groups XVII-XX and groups XXVIII-XXXV lack a special technical feature for the following reasons: groups XVII-XX are drawn to a method for treating a disorder associated with bone loss while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

44. The inventions listed as groups XXI-XXIV and group XXV lack a special technical feature for the following reasons: groups XXI-XXIV are drawn to a method for treating a disorder associated with unwanted bone growth while group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity.

45. The inventions listed as groups XXI-XXIV and group XXVI lack a special technical feature for the following reasons: groups XXI-XXIV are drawn to a method for treating a disorder associated with unwanted bone growth while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

46. The inventions listed as groups XXI-XXIV and group XXVII lack a special technical feature for the following reasons: groups XXI-XXIV are drawn to a method for treating a disorder associated with unwanted bone growth while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

47. The inventions listed as groups XXI-XXIV and groups XXVIII-XXXV lack a special technical feature for the following reasons: groups XXI-XXIV are drawn to a method for treating a disorder associated with unwanted bone growth while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

48. The inventions listed as group XXV and group XXVI lack a special technical feature for the following reasons: group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity while group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation.

49. The inventions listed as group XXV and group XXVII lack a special technical feature for the following reasons: group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

50. The inventions listed as group XXV and groups XXVIII-XXXV lack a special technical feature for the following reasons: group XXV is drawn to a method of screening a compound for its ability to modulate ERRα activity while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

51. The inventions listed as group XXVI and group XXVII lack a special technical feature for the following reasons: group XXVI is drawn to a method of screening a compound for potential efficacy in promoting bone formation while group XXVII is drawn to a method of screening a compound for potential efficacy in inhibiting bone formation.

52. The inventions listed as group XXVI and groups XXVIII-XXXV lack a special technical feature for the following reasons: group XXVI are drawn to a method of screening a compound for potential efficacy in promoting bone formation while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

53. The inventions listed as group XXVII and groups XXVIII-XXXV lack a special technical feature for the following reasons: group XXVII is drawn to a method of

screening a compound for potential efficacy in inhibiting bone formation while groups XXVIII-XXXV are drawn to a pharmaceutical composition.

A telephone call was made to Karen Magri on June 15, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Vivlemore whose telephone number is 571-272-2914. The examiner can normally be reached on Mon-Fri 8:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Leguyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tracy Vivlemore
Examiner
Art Unit 1635

TV
June 15, 2004

Karen A. Lacourciere

KAREN A. LACOURCIERE, PH.D
PRIMARY EXAMINER